

## REMARKS

Claims 1, 2, and 4-24 are pending. Claims 1, 2, 4-14 and 21-24 are under examination. Claims 1 and 11 have been amended. Support for the amendments can be found throughout the specification and the claims as filed. In particular, support for the amendments can be found, for example, on page 9, lines 4-20. Accordingly, these amendments do not raise an issue of new matter and entry thereof is respectfully requested.

Applicants appreciate the comments provided by Examiner McGarry in the Advisory Action dated May 18, 2009. With respect to the comment in the Office Action regarding claim 11 and the phrase "active site coding region," it is respectfully submitted that the meaning of this phrase would be clear to one skilled in the art based on the teachings in the specification. Nevertheless, the term "active site" has been deleted from claim 11.

### Rejection Under 35 U.S.C. § 112, Second Paragraph

The rejection of claims 1-10, 12-14 and 21-24 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite is respectfully traversed. The Office Action indicates that the previous amendment to recite "by at least 51%" has presented alleged ambiguity. Applicants respectfully maintain, for the reasons of record, that claim 1 is clear and definite. Nevertheless, claim 1 has been amended to delete the phrase "by at least 51%." Accordingly, Applicants respectfully submit that this rejection has been rendered moot and therefore request that this rejection be withdrawn.

### Rejections Under 35 U.S.C. § 102

The rejection of claims 1, 2, 4, 5 and 11 under 35 U.S.C. § 102(b) as allegedly anticipated by Hatakeyama et al., *Front. Sci. Ser.* 29:173-174 (2000), is respectfully traversed. Applicants respectfully maintain that the claimed compounds are novel over Hatakeyama et al.

Claim 1, as amended, is directed to a compound comprising a modified oligonucleotide consisting of 8 to 80 linked nucleosides and having a nucleobase sequence complementary to the coding region or 3' UTR of SEQ ID NO: 3 and wherein the compound inhibits the expression of hydroxysteroid 11-beta dehydrogenase 1. Claim 11, as amended, is directed to a compound 8 to

80 nucleobases in length which specifically hybridizes with at least an 8-nucleobase portion of the coding region or 3' UTR on a nucleic acid molecule encoding hydroxysteroid 11-beta dehydrogenase 1. Applicants respectfully submit that Hatakeyama et al. provides no teaching of a compound having a nucleobase sequence complementary to or which specifically hybridizes with a coding sequence or 3' UTR of a nucleic acid molecule encoding hydroxysteroid 11-beta dehydrogenase 1 such as SEQ ID NO:3. Absent such a teaching, Hatakeyama et al. cannot anticipate the claimed compounds. Accordingly, Applicants respectfully request that this rejection be withdrawn.

The rejection of claim 11 under 35 U.S.C. § 102(a) as allegedly anticipated by Souness et al., Steroids 67:195-201 (2002), is respectfully traversed. Applicants respectfully maintain that the claimed compound is novel over Souness et al.

Applicants respectfully submit that Souness et al. provides no teaching of a compound which specifically hybridizes with a coding sequence or 3' UTR of a nucleic acid molecule encoding hydroxysteroid 11-beta dehydrogenase 1, as recited in claim 11. Absent such a teaching, Souness et al. cannot anticipate the claim. Accordingly, Applicants respectfully request that this rejection be withdrawn.

**Rejection Under 35 U.S.C. § 103**

The rejection of claims 1, 2, 4-14 and 21-24 under 35 U.S.C. § 103 as allegedly obvious over Souness et al., *supra*, Hatakeyama et al., *supra*, Bennett et al., U.S. Patent No. 5,998,148, and Baracchini et al., U.S. Patent No. 5,801,154, is respectfully traversed. Applicants respectfully maintain that the claimed compounds are unobvious over any of Souness et al., Hatakeyama et al., Bennett et al. and/or Baracchini et al., alone or in combination.

As discussed above, neither of Souness et al. or Hatakeyama et al. teaches or suggests a compound having a nucleobase sequence complementary to or which specifically hybridizes with a coding sequence or 3' UTR of a nucleic acid molecule encoding hydroxysteroid 11-beta dehydrogenase 1 such as SEQ ID NO:3, as recited in Applicants' claims. Furthermore, neither of Bennett et al. nor Baracchini et al. cures the deficiencies of Souness et al. and/or Hatakeyama et al. Absent a teaching or suggestion of the claimed compounds, Applicants respectfully submit

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that none of Souness et al., Hatakeyama et al., Bennett et al. or Baracchini et al., alone or in combination, can render the claimed compounds obvious. Accordingly, Applicants respectfully request that this rejection be withdrawn.

In light of the amendments and remarks herein, Applicants submit that the claims are now in condition for allowance and respectfully request a notice to this effect. The Examiner is invited to call the undersigned agent if there are any questions.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 502624 and please credit any excess fees to such deposit account.

Respectfully submitted,

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